

REMARKS

After careful consideration of the Office Action, this application has been amended accordingly, and favorable reconsideration on the merits thereof is at this time respectfully requested.

At page 2, paragraph 2 of the Office Action, the Examiner advised patents cited in the specification would not be considered unless "submitted in a separate paper." The patents set forth in the specification were listed by way of an Information Disclosure Statement dated and filed January 11, 2002 citing the three patents not cited in the International Search Report. The two remaining patents were cited in the specification and in the International Search Report and, therefore, are not required to be noted on an Information Disclosure Statement or submitted by the undersigned. Therefore, all patents should have been considered by the Examiner. However, as a precaution, there is attached hereto form PTO/SB/08a listing the patents cited in the International Search Report. No patent copies are submitted as these copies should have been forwarded to the United States Patent and Trademark Office by WIPO.

The three pages of the specification objected to by the Examiner at page 2, paragraph 3 of the outstanding Office Action have been appropriately corrected.

At page 3 of the outstanding Office Action, paragraphs 5 through 9, the Examiner objected to several claims because of the absence of antecedent basis. All of the claims have been amended (except for claim 28 which was cancelled), and each is in compliance with the second paragraph of 35 U.S.C. § 112.

The Examiner rejected claims 1, 2, 4-11, 13, 18, 20 and 28 "under 35 U.S.C. § 103(a) as being unpatentable over Murray et al. '789 in view of the Japanese patent to Moriki et al." The Examiner correctly describes the construction machine of Murray et al. between page 3, line 4 from the bottom through page 4, line 10 ending with the sentence -- "Murray et al. '789 does not explicitly disclose that the sleeve is a one

pieced sleeve." -- Perhaps best stated in keeping with the decision of Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966), Murray et al. discloses a "milling drum 106 consisting of sections 106A and 106B (as illustrated in FIGS. 8 and 9) is mounted on the machine." (See column 8, lines 4 through 6.) Additionally, "the two sections 106, 106A of the drum 106 are connected to each other via screws 160 passing through holes 162 in each of the sections with the screws threadedly engaging a tapped hole 164 in the opposing sections." (See column 8, lines 42-46.) The next paragraph states that a single person in a limited amount of time can exchange milling drums of different sizes, and at the bottom of column 6, such changing can be accomplished "by one man using simple available hand tools in the course of **a few hours**. (Emphasis added.)

Therefore, the scope and content of the primary patent to Murray et al. is directed **only to segmented** milling drums and absent therefrom is any thought of a one-piece milling drum or tube which can be **axially slid** upon or from a roller base body or a member connected thereto, as was specified in original claim 1 and claim 1 as now amended. "Under section 103, the scope and content of the prior art are to be determined." (See Graham, supra, 467.) Clearly, the scope and content of the prior art patent to Murray et al., both as disclosed and claimed, has nothing to do with a one-piece axially slidable milling tube or drum. Therefore, the Murray et al. patent fails the first of the three conditions set forth in the Graham, supra, decision "which must be satisfied" in order to support a rejection based upon obviousness under 35 U.S.C. § 103(a). The Court of Appeals, Federal Circuit, in In re Fritch, 23 USPQ2d 1780, at paragraph 3, following the caption "**Patentability/Validity-Obviousness-Combining References (Section 115.0905)**" stated:

Claims for landscape edging device are not prima facie obvious in view of combined teachings of two prior patents, **since primary reference does not suggest overall**

flexibility and landscape retention function of claimed device, and said secondary reference does not, merely by virtue of flexibility of device described therein, suggest extensive modifications which would bring primary reference into conformity with application claims. (Emphasis added.)

As in In re Fritch, the primary patent to Murray et al. does not suggest a one-piece milling tube or drum which can be axially slidably mounted upon or removed from a roller base body or a member connected thereto. Murray et al. does not even contemplate the fact that the segmented milling drum exposes the fasteners 160 (Figures 9 and 13) directly to the harsh milling environment which during operation, material milled from road surfaces or the like would fill the bores 162 (Figure 9) making the task of removal considerably difficult, if not impossible, and hardly within "**a few hours**." Corrosion and rusting is also a factor to be considered and it is submitted that the hoped-for milling drum change "in the course of a few hours" is highly improbable. However, the main point made by the undersigned is that Murray et al. is totally unconcerned with a single piece milling drum and, as a matter of fact, does not teach or suggest the manner in which a one-piece sleeve might be axially slidably mounted upon the sleeve 122 (Fig. 8.)

The Examiner next states: "The Japanese patent to Moriki et al. discloses a milling drum that is composed on one piece." Such **may be** the case, but the alleged one-piece sleeve 1 is **not** associated with a roller base body, corresponding to the roller base body 19 of the present invention or a member connected thereto, and is not mounted through axial/coaxial relative sliding movement. One need but compare Fig. 8 of Murray et al. and Fig. 2 of Moriki et al. to rapidly determine that both are directed to two separate and distinct inventions. Murray et al. are concerned with radially assembling and disassembling segmented milling drums 106A, 106B relative to a sleeve 122, whereas Moriki et al. patent are concerned with nothing more than feeding hydraulic fluid to a motor through an end plate which is flush with a rotor drum so as to

"make as small as possible the projected section of a rotor drum driving section or the like which makes a hindrance of flush cut on road repairing work or the like." (See Moriki et al., Abstract.) In other words, the teaching, suggestion and/or motivation of the Moriki et al. patent is to fully contain a driving device within a rotor drum of a milling machine to cut as close as possible (flush cut) with respect to vertical obstructions, such as, for example, curbs adjacent roadways which are being milled.

As was stated in the In re Fritch, supra, decision -- "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." Murray et al. and Moriki et al. fail to suggest any motivation for, or desirability of, the changes suggested by the Examiner. Just as in the In re Fritch decision, in the instant rejection of claim 1, "the Examiner relied upon hindsight to arrive at the determination of obviousness." One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. In re Fine, 837 F.2d at 1075, 5 USPQ2d at 1075, 5 USPQ2d at 1600.

In view of the foregoing, the formal allowance of claim 1, as well as all of the remaining dependent claims under rejection, is considered proper and would be most appreciated.

The formal allowance of this application and all of the claims of record at an early date would be most appreciated.

Respectfully submitted,

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